



ATTORNEY DOCKET NO.: FRANK'S INT.-007:CP2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: DONALD E. MOSING, ET AL.

SERIAL NO.: 09/206,876

EXAMINER: W. NEUDER

FILED: DECEMBER 08, 1998

ART UNIT: 3672

FOR: *"IMPROVED METHOD AND MULTI-PURPOSE APPARATUS FOR
DISPENSING AND CIRCULATING FLUID IN WELLBORE CASING"*

AFFIDAVIT OF WILLIAM E. JOHNSON, JR. IN SUPPORT OF
PETITION TO THE COMMISSIONER UNDER 37 C.F.R. § 1.137(b)

STATE OF TEXAS §
COUNTY OF HARRIS §

William E. Johnson, Jr., being first duly sworn, does aver as follows:

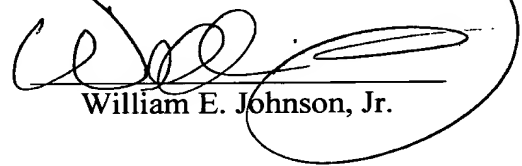
- 1) that he is a citizen of the United States of America, residing at 8823 Kilrenny Drive, Spring, Texas 77379;
- 2) that he is an attorney, in good standing, licensed by the Supreme Court of Texas, State Bar Card No. 10826000, and has been so licensed from September 20, 1965 to the present;
- 3) that he is a Patent Attorney in good standing, registered to practice before the United States Patent and Trademark Office in patent cases, Registration No. 22,719, and has been so registered from August 26, 1965 to the present;
- 4) that he is employed by The Matthews Firm, 1900 West Loop South, Suite 1800, Houston, Texas 77027, as a Patent Attorney, and has been so employed since February, 16, 1999, to the present;
- 5) that The Matthews Firm specializes in the practice of law involving, primarily, Intellectual Property;
- 6) that on February 16, 1999, The Matthews Firm, then known as Matthews, Joseph, Shaddox and Mason, relocated its Houston Offices from 1800 Bering Drive, Suite 900, Houston, Texas 77057, to 1900 West Loop South, Suite 1800, Houston, Texas 77027;

- 7) that the subject U.S. Patent Application 09/206,876 was filed on December 8, 1998, while The Matthews Firm was still located at the Bering Drive address identified herein above. A copy of the Filing Receipt is attached as Exhibit A;
- 8) that on or about February 16, 1999, The Matthews Firm filed with the United States Postal Service in Houston, Texas, the government form used for forwarding mail from an old address (1800 Bering Drive) to a new address (1900 West Loop South). A sample copy of a similar such form, but bearing a date of "September 2000", PS Form 3575, is attached as Exhibit B, and on its face purports to be effective for twelve (12) months, viz., until on or about February 16, 2000; attached Exhibit C also shows the twelve (12) month effective period;
- 9) that, on or about February 16, 1999, The Matthews Firm began the process of filing with the United States Patent and Trademark Office individual notices of change of address for each and every pending patent application and each and every pending application for federal registration of trademarks and service marks; two sample copies of the form used by The Matthews Firm for such notice are attached collectively as Exhibit D;
- 10) that despite the intention of The Matthews Firm to file a Notice of Change of Address in every one of its pending application with the United States Patent and Trademark Office, there was apparently no such notice, as such, filed with the United States Patent Office with respect to the subject U.S. Patent Application Serial No. 09/206,876, because a thorough search of such file in The Matthews Firm has failed to provide any proof of such filing;
- 11) that the failure of The Matthews Firm to provide the Notice of Change of Address in accord with the form used in the attached Exhibit D was unintentional, inadvertent, without any intent to delay, and without any intent to generate fraud upon the United States Government, or any of its agencies, including the United States Patent and Trademark Office, or upon any individual, person, company or other entity;
- 12) that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional;
- 13) that on November 15, 1999, some nine (9) months after The Matthews Firm relocated its offices to the address on 1900 West Loop South, an Office Action (copy attached as Exhibit E) dated November 5, 1999, addressed to its old offices at 1800 Bering Drive, was received by The Matthews Firm at its new offices on 1900 West Loop South, presumably because of the form such as Exhibit B having been filed less than twelve (12) months before February 16, 1999, with the United States Postal Service;
- 14) that on February 7, 2000, The Matthews Firm filed a response (copy attached as Exhibit F) to the Office Action of February 5, 2000, a response which shows on its page 17 the current address of The Matthews Firm;

- 15) that the response referenced in paragraph 14, above, failed to indicate that the address shown was in fact a change of address, as suggested in the penultimate paragraph of MPEP 601.03;
- 16) that on or about March 23, 2000, a Notice of Allowability (copy attached as Exhibit G) of Claims 1-36 was mailed by the United States Patent and Trademark Office to The Matthews Firm, but to the old address on Bering Drive. The Matthews Firm did not receive the Notice of Allowance, the Notice of Allowance, or the Notice of Issue Fee Due, presumably because March 23, 2000 was thirteen (13) months past the date of the address change filed with the United States Postal Service;
- 17) that on July 10, 2000, The Matthews Firm filed a Supplemental Response (copy attached as Exhibit H) in the subject patent application; that on September 15, 2000, the United States Patent and Trademark Office mailed a document (copy attached as Exhibit I), mailed to the old address on Bering Drive, indicating that the Supplemental Response (Exhibit H) was filed after the Issue Fee had been paid (not accurate because the Issue Fee had not been paid); that the document mailed on September 15, 2000 was never received by The Matthews Firm;
- 18) that on December 4, 2000, the United States Patent and Trademark Office mailed a Notice of Abandonment to the old address on Bering Drive (copy attached as Exhibit J); that the document mailed on December 4, 2000 (Exhibit J) was never received by The Matthews Firm;
- 19) that sometime in mid December, 2000, The Matthews Firm received a telephone call from Ms. Betty Powell, a member of the Publication Department of the United States Patent and Trademark Office (703-308-7438), inquiring as to whether the Issue Fee for the subject application had been paid; that it was explained to her that neither the Notice of Allowance nor the Notice of Abandonment (attached as Exhibit J) were ever received by The Matthews Firm;
- 20) that Ms. Betty Powell of paragraph 19 responded by telling the affiant Mr. William E. Johnson, Jr. that the prosecution file had been returned to the Art Unit 3672;
- 21) that in mid December, 2000, the affiant Mr. William E. Johnson, Jr. telephoned Primary Examiner William Neuder concerning the whereabouts and status of the subject application; that Examiner Neuder indicated that he would have to locate the file and get back to the affiant Mr. William E. Johnson, Jr.;
- 22) that on January 9, 2001, Examiner Neuder telephoned the affiant, William E. Johnson, Jr. and informed him that the file had been located, that the file had been ordered and that the parts of the file never received by The Matthews Firm would be faxed to the affiant William E. Johnson, Jr.;

- 23) that the documents attached as Exhibits G, I and J were faxed to the affiant William E. Johnson, Jr. on Wednesday, January 10, 2001; that all three documents had been mailed originally to the old address on Bering Drive; that none of the three documents were received by The Matthews Firm prior to January 10, 2001;
- 24) that as part of preparing this Affidavit, an existing listing was printed of the "Mail Page" for the time period of March 1, 2000 through June 1, 2000 (copy attached as Exhibit K). An existing docket for the same time period of March 1, 2000 through June 1, 2000 (copy attached as Exhibit L) was printed to show whether the Notice of Allowability, the Notice of Allowance or Issue Fee Due were ever received by The Matthews Firm; that the "Mail Page" is a daily record showing all patent and trademark mail received, a record which is distributed every day or so to the personnel of The Matthews Firm, the Docket is similarly distributed once a month; that if the Notice of Allowance were mailed out on March 23, 2000, the due date for payment would have been June 23, 2000. These dates, if the documents were in fact received by The Matthews Firm, would have been printed in both of the Exhibits K and L; that reference to the Issue Fee being due for the subject application (our Docket No. FKI-26 and later on FKI-007:CP2) is found in neither Exhibit K or L;
- 25) that based upon all of the evidence in this matter as presented herein, the Notice of Allowability, the Notice of Allowance and the Notice of Issue Fee being due were not timely received, and that the subject application should be revised under 37 C.F.R. 1.137 (b) to allow the Issue Fee to be timely paid.

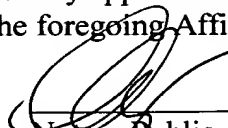
FURTHER AFFIANT SAYETH NOT.



William E. Johnson, Jr.

STATE OF TEXAS §
COUNTY OF HARRIS §

On this the 16th day of January, 2001, personally appeared before me William E. Johnson, Jr. who stated to me under oath that he has read the foregoing Affidavit and the same is true and correct in all respects.



Notary Public
State of Texas
My Commission Expires: 2/23/04

